

U.S. Patent Application Serial No. 09/944,595
Attorney Docket No. 011120

REMARKS

It is believed that this Request for Reconsideration is fully responsive to the Office Action dated **June 10, 2003**.

Claim Rejections under 35 USC §103

Claims 1-5 are rejected under 35 USC §103(a) as being unpatentable over 2002/0053629 to Hokugoh in view of US Patent No. 6,231,020 to Willson.

This rejection is respectfully traversed.

In rejecting the claimed invention, the outstanding Office action has specifically stated that “[r]egarding claims 1-5, Hokugoh did not disclose that said low friction member comprises a plurality of generally spherical ball-shaped or mushroom-shaped members.” The Applicant agrees with this Office assessed shortcoming of Hokugoh.

To supplement this shortcoming, the Office proposed that “[s]ince the invention of Hokugoh and of Willson are from the same field of endeavor (swiveling support devices for computer equipment), the purpose of the spherical ball-shaped low friction members disclosed by Willson would be recognized in the invention of Hokugoh. It would have been obvious to a person of ordinary skill in computer art at the time the invention was made to substitute the low friction member (12) of Hokugoh with a plurality of spherical ball-shaped low friction members as taught by Willson, in order to enhance convenience for a user by reducing the friction between said first and second members of Hokugoh.”

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From the explanations given by the outstanding Office, it is clear that Hokugoh and Willson are combined because “Hokugoh and of Willson are from the same field of endeavor”, and spherical ball-shaped low friction members of Willson would enhance convenience for a user by reducing the friction between said first and second members of Hokugoh.”

Regarding the second reason, the Office has not offered any evidence that so many spherical ball-shaped low friction members of Willson in congregate would provide a lower friction than a single sliding sheet of Hokugoh. Therefore, this is strictly a conjecture on the part of the Office. Should the Office wish to maintain this position, evidence supporting this conjecture is respectfully requested.

Regarding the first reason, from the perspective of the U.S. Patent Office and the court system, a *prima facie* case of obviousness is not established by a same field of endeavor standard. Regarding establishing a *prima facie* case of obviousness, section 2143 of the MPEP has specifically stated that:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 466, 20 USPQ2d 1438 (Fed. Cir. 1991).”

Therefore, it is both a court position and a Patent Office position that to establish a *prima facie* case of obviousness, 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Regarding what is suggested and that can be found in Hokugoh, in paragraph 0030, Hokugoh has specifically suggested

"[t]he sliding sheet 12 is a circular sheet made of a synthetic resin having a good sliding property. The middle portion of the sliding sheet 12 is provided with a hole 31. The sliding sheet 12 is placed between the substrate 11 and the tilting unit 13 on which the middle cover 14 is placed so that the middle cover 14 can pivot smoothly on the substrate 11."

Therefore, the specific teaching of Hokugoh is a sliding sheet made of a synthetic resin having a good sliding property. There is no teaching or suggestion of ball bearings in Hokugoh.

It should also be noted that as shown in Figure 1 of Hokugoh, the sliding sheet only provides sliding action to a light weight liquid crystal display 1 which might weight about 6-7 pounds.

In contradistinction, as clearly shown in Figure 2 of Willson, the ball bearings are meant to provide rolling action to a platform 40, a cathode ray tube display and a computer. The weights of these items added together might very well be 60-70 pounds. Therefore, the ball bearing of Willson is designed to provide sliding action to items that weight 10 times more than the sliding sheet 12 of

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Willson. It would be recognized by a person of ordinary skill in the art that there will be a tremendous amount of waste and a tremendous amount of production cost in adopting the ball bearings of Willson into Hokugoh.

Furthermore, as clearly shown in Figure 5 of Hokugoh, sliding sheet 12 is of a disk shaped held between the first member 14 and second member 11 by guiding parts 21-22 and pin 17e. Should the ball bearings of Willson be adopted into Hokugoh, they cannot be held between the first member 14 and second member 11 by guiding parts 21-22 and pin 17e, because the ball bearings would inevitably be scattered off the first and second members. MPEP 2143.01 has specifically stated that:

“[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).”

Therefore, there is indeed no objective teaching or suggestion for adopting the ball bearings of Willson into Hokugoh.

Should the Office assert that the adoption is not only limited to the ball bearings, other aspects that would contain the ball bearings of Willson should also be adopted. Then the Office is suggesting that the entire invention of Hokugoh should be substituted by the invention of Willson, because both inventions are merely regarding swivel devices. The hindsight nature of this rejection becomes apparent. It is also well settled that:

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

For the foregoing reasons, the claimed invention is not rendered obvious by the asserted prior art references. Reconsideration and withdrawal of this rejection are respectfully requested.

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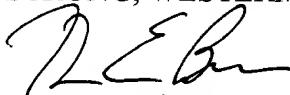
Conclusion

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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